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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/910,641	
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	First Named Inventor	PERRIANN M. HOLDEN	
	Art Unit	3765	
	Examiner Name	ALISSA HOEY	
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Practitioner's Docket No.: 810101-1

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of Perriann M. Holden)	
)	
Application No. 09/910,641)	Group No: 3765
)	
Filed July 20, 2001)	Examiner: Alissa Hoey
)	
For: Protective Attachment)	

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APPELLANT'S REPLY BRIEF (37 C. F. R. §1.192)

This Reply Brief is filed in triplicate, and is filed in response to the examiner's answer mailed on February 23, 2004.

CERTIFICATE OF TRANSMITTAL UNDER 37 C.F.R. § 1.8 (a)

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Date: March 26, 2004

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REPLY BRIEF

Reply to Answer of Examiner

Before considering the answer of the examiner relative to the claims on appeal, Appellant believes it may be beneficial to briefly review the structure of the indexing device disclosed and taught by *Yonkers (US 3,985, 383)* and the structure of novelty item as disclosed and taught by Appellant. For the purpose of this review, reference should be made to FIG. 4 of the *Yonkers reference*, and FIGS. 7 and 18 of Appellant's patent application, as published in Patent Application Publication No.: US 2002/0138896. To assist in this discussion, a side-by-side comparison of the two structures is also provided in this Reply on the next page.

A. Single-Piece Construction as Opposed to A Two-Piece Construction

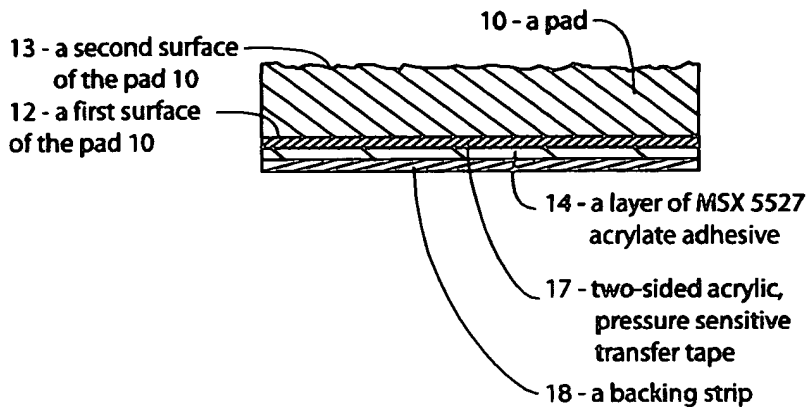
When seen in cross-section, as seen in the side-by-side comparison of the two structures on the next page, it can be clearly visualized that the structure of the indexing device of the *Yonkers reference* is substantially different than the structure of the novelty device under appeal. In this regard, the indexing device (10) as taught by the *Yonkers reference* and as seen in FIG. 4, is a two-piece construction while the novelty item as taught by Appellant and as seen in FIGS. 7 and 18, is a single-piece construction.

The two-piece construction of the indexing device (10) as taught by the *Yonkers reference* comprises a layer of plastic film (14) having two surfaces, a first surface (15) and a second surface (19), which has secured thereto by cement, a mass of traction material (18). In this regard, the *Yonkers reference* teaches the following:

"In accordance with a further important feature of the present invention, a mass of traction material 18 having a very high coefficient of friction with respect to the objects to be indexed is disposed on a second side or surface 19 of the film 14. The mass of traction material 18 may be of the same general configuration as the layer of plastic film 14 and may be attached thereto by cement. The mass of traction material 18 may, in a specific embodiment, be an elastomeric material such as foam and sponge rubber containing glycerine; or, in an alternate embodiment, the mass of traction material 18 may be smooth rubber stock that has been cross-cut or hatched (FIG.3) to increase its traction capability. The mass of traction material 18 may alternately comprise rubber threads which are released from a liquid rubber container onto the plastic layer of film 14."
(Col. 3, lines 14-29).

The single-piece construction of the novelty item as taught by Appellant's patent

NOVELTY ITEM



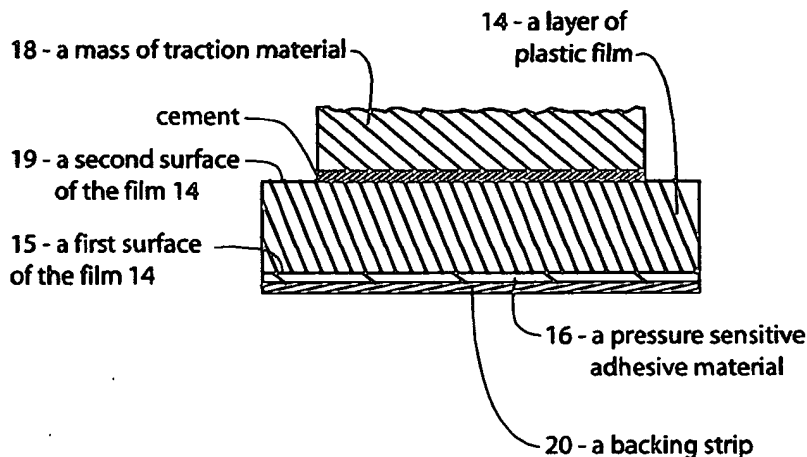
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application comprises a thin pad (10) with its bottom surface having a non-slip texture. In this regard, the text of Appellant's pending patent application, teaches the following:

"As shown in FIGS 1 and 2, the pad 10 is of single piece construction and adhesively covers the entire under-surface of foot 1. Pad 10 is relatively thin and made to conform to the shape of the foot bottom, including toes 2." (Page 2, paragraph 0027).

"Bottom surface 13 is intended for contacting the ground during use. It is preferred that the bottom surface 13 is waterproof or water resistant and is further provided with a non-slip texture. If desired, bottom surface 13 can be decorated with color, patterns, messages, trademarks, or advertisements." (Page 2, paragraph 30)

INDEXING DEVICE



YONKERS

As will be explained in greater detail when replying to the answer of the examiner, this single-piece construction verses the two-piece construction of the *Yonkers reference* is a key feature that patentably distinguishes the novelty item of the present invention from the indexing device (10) as taught by the *Yonkers reference*.

B. Adhesive Layer with Backing Strips

Both the indexing device (10) of the *Yonkers reference* and the novelty item as taught in Appellant's patent application are intended to be secured to a body part. That is, the indexing device (10) as taught by the *Yonkers reference* is constructed to be attached to a fingertip for helping to index documents, while the novelty item as taught by Appellant, is constructed to be attached to the bottom part of a user's foot for novelty decoration purposes. In this regard, both the indexing device (10) of the *Yonkers reference* as well as the novelty item as taught in Appellant's patent application, include adhesive layers covered with protective backing strips.

As seen in FIG. 4 and in the side-by-side comparison provided in this Reply, the adhesive layer and backing strip as taught by the *Yonkers reference* generally comprises a pressure sensitive adhesive material (16), which has secured thereto a continuous backing strip (20). In this regard, the *Yonkers reference* teaches the following:

"In accordance with an important feature of the present invention, a first side or surface 15 of the layer of plastic film 14 is coated with a pressure sensitive adhesive material 16 (FIG. 4) to enable the layer of plastic film 14 to be attached to the finger 11 or to another object. Through the use of the adhesive material 16, no other supporting or attaching means is required during the use of the indexing device 10. The adhesive material 16 can be of any type well known in the art and may be of the same material as that used on ordinary adhesive tape. In addition, the adhesive material 16 may cover either a portion of the side 15 of the film 14 or the entire side 15 of the film 14 depending on the adhesive qualities of the material 16 and the desirability of securing the complete side 15 of the film 14 onto the finger 11." (Col. 2, line 66 to Col. 3, line 13).

"A plurality of indexing devices 10 can be attached to a continuous backing strip 20 (FIG. 5) through the use of the adhesive material 16 and placed in dispensing containers such as those commonly used by adhesive tag manufacturers. When an indexing device 10 is to be used, it may be separated from the continuous backing strip 20 and placed on the finger 11." (Col. 4, lines 3-9).

The adhesive layer and backing strip as taught by Appellant's patent application comprises a layer of transfer tape (17), and a layer of acrylate adhesive (14). A peel sheet (18) protects the adhesive layer until ready to use. In this regard, the text of Appellant's pending patent application, teaches the following:

"As shown best in cross section in FIG. 7, pad 10 includes top surface 12 and a bottom surface 13. As shown in

FIG. 18, the several layers of a kit include the pad 10 made of ethylene vinyl acetate (EVA) (EVA-most preferred thickness of 1/16 & Prime thick), a two-side acrylic, pressure sensitive adhesive transfer tape 17 on the top surface 12, a layer of MSX 5527 acrylate adhesive 14 (A polyurethane backing with acrylate adhesive may be obtained from 3M Health-care as MSX 5527 acrylate polyurethane 1.2 mil thick tape), and a peel sheet 18 protecting the adhesive until ready to use." (Page 2, paragraph 0028).

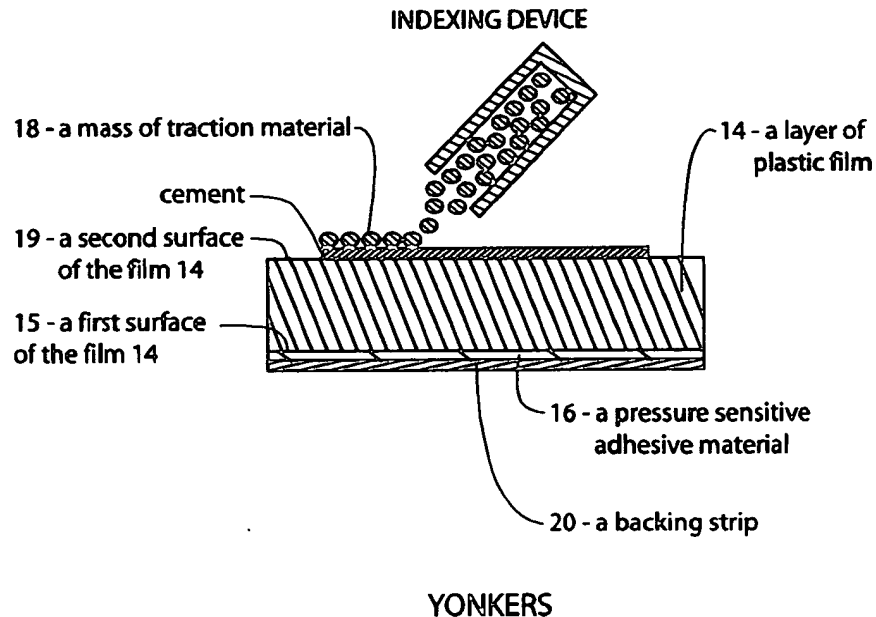
Reply to Answer of Examiner

With reference to claim 21, Appellant has argued that the flexible pad (10) as seen in FIGS. 7 and 18 (and in the side-by-side comparison provided on page 1 of this Reply) has a lower surface (13) with a non-slip texture, while the examiner has answered that the indexing device (10) has "a lower surface with a non-slip texture", using FIG. 4 and identifying the mass of traction material (18) while referencing the following text at Col. 4, lines 21-29:

"The mass of traction material (18) may, in a specific embodiment, be an elastomeric material such as foam and sponge rubber containing glycerine; or, in an alternate embodiment, the mass of traction material (18) may be smooth rubber stock that has been cross-cut or hatched (FIG. 3) to increase its traction capability. The mass of traction material (18) may alternately comprise rubber threads which are released from a liquid rubber container onto the plastic layer of film (14)."

In reply to the answer of the examiner, Appellant asserts that the mass of traction material (18) is a separate element, which as noted in the text referenced by the examiner, can even be rubber threads, which are released from a container and cemented to the lower surface

of the plastic layer of film (14) as shown in the illustration below.



The mass of traction material (18) as seen in the drawings has an upper surface and a lower surface. The layer of plastic film (14) also has an upper surface and a lower surface. In this regard, it is the upper surface of the traction material (18) that has texture and not the upper surface (19) of the layer of plastic film 14.

In short then, the mass of traction material (18) is not integral to the layer of plastic film (14) as required by claim 21 which provides in pertinent part:

"21. A novelty fashion wear item, comprising:
a flexible pad having an upper surface and a lower surface with a non-slip texture..." (Emphasis added)

In the English language, the subject of the phrase "a flexible pad having" is "a flexible pad". Accordingly, the word "having" is directed to the "flexible pad". Moreover, the word "having" as defined in "The Random House College Dictionary" means "to be identified or distinguished by: posses the characteristic of: This cloth has a silky texture." Claim 21 therefore requires that the pad (10) itself posses the characteristic of a non-slip texture and not something that is applied and secured to the flexible pad (10) to give it a non-slip texture, as taught by the *Yonkers reference* and suggested by the answer of the examiner.

In support of Appellant's Reply, Appellant would further direct the reader to FIG. 6 of the *Yonkers reference* and to the text at Col. 3, 18-21 and at Col. 4, lines 10-13, which provide in pertinent part the following:

"The mass of traction material 18 may be of the same general configuration as the layer of plastic film 14 and may be attached thereto by cement." Emphasis added. (Col 3, lines 18-21)

"Further, alternate embodiments of the indexing device 10 include variations of color and shape (FIG. 6) of both the mass of traction material 18 and the layer of plastic film 14." Emphasis added. (Col 4, lines 10-13)

As shown in FIG. 6 and as taught by the preferred embodiment, both the layer of plastic material (14) and the mass of traction material (18) are clearly identified as separate elements. In context of the language, "of the same general configuration" and "and may be attached" in the text at (Col 3, lines 18-21) and "of both" in the text at (Col 4, lines 10-13), one can only conclude that the elements (the layer of plastic material (14) and the mass of traction material (18) are separate and distinct from one another. In short then, it is clear that the *Yonkers reference* teaches away from the lower surface 19 of the layer of plastic film 14 having "a non-slip texture" based upon both the drawings of the *Yonkers reference* and the text of the *Yonkers reference*.

With reference to claim 21, the examiner has further noted that Appellant argued that "Yonkers fails to teach 'said pad having its lower surface provided with indicia to decorate said contoured surface area'", The examiner has answered by stating "Yonkers teaches indicia chosen from colors and shapes to decorate the contoured area", referencing FIG. 6, and identifiers 22, 24, 26 and 28 at Column 4, lines 10-19, which provides in pertinent part the following:

"Further, alternate embodiments of the indexing device 10 include variation of color and shape (FIG. 6) of both the mass of traction material 18 and the layer of plastic film 14. For example, the device 10 may be formed in the shape of a heart 22, a square 24, a clover 26 or a diamond. Each of these alternate embodiments of the device 10 is constructed in essentially the same manner as that set forth with respect to the preferred embodiment and may be attached to a continuous backing strip 20."

In reply, Appellant asserts that FIG. 6 of the *Yonkers reference* only illustrates indexing devices (22, 24, 26, and 28) only with different shapes as no indicia are indicated in FIG. 6. The *Yonkers reference* also makes it clear that the embodiments illustrated in FIG. 6 must be

constructed in the same manner as with respect to the preferred embodiment, since the *Yonkers reference* provides:

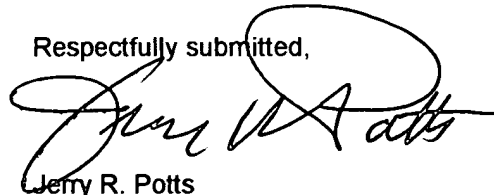
"Each of these alternate embodiments of the device 10 is constructed in essentially the same manner as that set forth with respect to the preferred embodiment and may be attached to a continuous backing strip 20." (Emphasis added)

In this regard, with reference to the preferred embodiment, the *Yonkers reference* at Col.3, lines 18-19, teaches, "The mass of traction material 18 may be of the same general configuration as the layer of plastic film 14 and may be attached thereto by cement." (Emphasis added).

In short then, the lower surface of the layer of plastic film (14) in the preferred body construction is coated with a layer of cement in order to attach the mass of traction material (18) to this lower surface. Accordingly, the *Yonkers reference* teaches away from "said pad having its lower surface provided with indicia" since the *Yonkers reference* in the preferred embodiment teaches providing the lower surface (19) of the plastic film (14) with cement to secure the mass of traction material 18 to this surface and not "providing the lower surface with indicia..." as recited in claim 21.

Dated: March 22, 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jerry R. Potts", with a large, stylized loop at the end.

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